REMARKS

Claims 1-13 are pending in the application; the status of the claims is as follows:

Claims 1-6, and 10-12 are rejected under 35 U.S.C. § 103(a) over Ohmori, U.S. Patent No. 5,790,193, in view of Watanabe, U.S. Patent No. 6,686,958;

Claims 7-9, and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ohmori.

The mention, in the Office Action, that no claim for foreign priority under 35 U.S.C. § 119(a)-(d), has been received, is noted with appreciation. Submitted herewith is a copy of the Certified Copy of Priority Document for Japanese Patent Application No. 11-354152, and the transmittal document for the priority document, both of which were previously filed with the Application documents on December 13, 2000. Further attached is a copy of the return receipt post card that accompanied these documents when they were originally submitted to the USPTO. The post card bears the stamp of the USPTO mail room indicating that these documents were received on December 13, 2000. Accordingly, in view of the evidence that a certified copy of the priority document has been submitted and received by, the USPTO, acknowledgement of receipt of this document to support the claim for foreign priority under 35 U.S.C. § 119(a)-(d) is respectfully requested.

The indication in the office action that the previous grounds of rejection have been withdrawn and new grounds applied in noted. The additional indication that the present office action is "non-final" is noted with appreciation.

The examiner's careful and detailed comments addressing applicant's prior arguments are noted with appreciation. As explained more fully in the remarks below, notwithstanding the examiner's clear comments and explanation for his position, applicants believe that the references cited under section 103 fail to provide a suggestion for their combination and do not suggest the currently claimed inventions. The claims

rejected under section 103 are believed to distinguish these references without amendment.

By this response, the claims rejected under section 102 have been amended to clarify that the user specified sequence is independent of the order in which the image data is stored on the media.

35 U.S.C. § 102(b) Rejection

The rejection of claims 7-9, and 13 under 35 U.S.C. § 102(b) as being anticipated by Ohmori, is respectfully traversed based on the following.

Claim 7, as now presented, recites:

> A digital camera comprising:
> a reader which can read image data from any of two or more recording media;
> a display which performs display of the image; and
> a display controller that, by handling a plurality of items of image data recorded in the two or more recording media in a sequence based on a user specified rule specified independently of the order in which the items of image data are recorded in the two or more recording media, causes said display to sequentially display the plurality of images in accordance with the sequence. (Emphasis Added.)

Thus, claim 7 requires that the display controller be responsive to a user specified rule for the sequence in which the images are to be displayed. Importantly, the claim now recites that this rule is "specified independently of the order in which the items of image data are recorded in the two or more recording media." In the current office action, the examiner has alleged that there is an implied sequence rule based simply on the order in which the pictures are taken or stored in the memory. However, that is not what claim 7 is trying to claim. Instead, once the images are stored, claim 7 is directed to a system where the user can input a display sequence rule that is separate and independent of the storage order of the images on the media.

Ohmori does not disclose suggest or teach a system having this limitation and thus cannot anticipate claim 7, or claims 9 and 10, which depend therefrom.

Claim 13 has been amended to clarify that the input rule is independent of the order in which the items of image data are recorded in the two or more recording media. Because Ohmori does not disclose suggest or teach a system having this limitation, Ohmori cannot anticipate claim 13.

Accordingly, it is respectfully requested that the rejection of claims 7-9, and 13 under 35 U.S.C. § 102(b) as being anticipated by Ohmori, be reconsidered and withdrawn.

35 U.S.C. § 103(a) Rejection

The rejection of claims 1-6, and 10-12 under 35 U.S.C. § 103(a), over Ohmori in view of Watanabe, is respectfully traversed based on the following.

As presently presented, Claim 1 requires inter alia:

> A digital camera comprising:
> a reader that can read image data from two or more recording media;
> a display which performs display of the image data; and
> a display controller which causes said display to display information that specifies the recording medium from which the image data was read as well as the image based on the image data.

Thus, claim 1 is directed to a digital camera that has certain structures and capabilities. The claimed camera must include a reading device which can read image data from two or more recording media and a display controller which certain features. Among them, that the controller can operate the display so as to show both image data from one of the two or more recording media, as well as information which specifies which one of the recording media the displayed image was read from.

Ohmori discloses a device which may be used with a digital camera. Applicants have previously explained that this is not a digital camera but, instead, a device used with a digital camera. Putting that aside, however, even if the device of Ohmori can display image information from more than one memory, Ohmori fails to disclose or suggest the limitation of claim 1 that when an image is displayed, Ohmori does not also show "information that specifies the recording medium from which the image data was read." For at least this reason, Ohmori, by itself, is unable to render obvious the invention of claim 1.

To overcome the deficiency of Ohmori, the examiner attempts to combine that reference with Watanabe. This combination, however, still fails to disclose or suggest the current claim.

Watanabe discloses that digital cameras can be connected to a computer and that image data can be transferred there between. Watanabe also discloses that the computer application can show a source (e.g., camera) window and a destination (e.g., computer) window to help the user during transfer of image data.

In order to make out a prima facie case of obviousness, there must be a motivation to combine the references in the manner claimed and the combination must not change the operation of the references being combined. Here, there is simply no suggestion in Ohmori and/or Watanabe to take the computer features of Watanabe and combine them with the camera features of Ohmori, much less to both combine and also to modify the features in a way to result in the invention claimed. Attempting to shoehorn the features of Watanabe into Ohmori to arrive at the present invention would also require a change in the concept of operation of the apparatus of these references.

In Watanabe, there are two independent systems connected together: a computer and a camera. Because data will be copied between the two, Watanabe teaches that a window for the remote device (i.e., the camera or the data source) and a window for the local device (*i.e.*, the computer or data destination) can be shown.

A direct combination of Watanabe and Ohmori is nonsensical because unless there are two independent systems for data transfer there between, the features of Watanabe do not apply. That is, Watanabe is quite different than a single system (such as a camera alone) that has two recording media. In dealing with a single device such as a camera, the two media do not correspond to a remote system and a local system or to a source and a destination for copying data there between. Instead, in the camera, the two media are alternative locations for storing data in the same system. Thus, the teachings of Watanabe directed to data management between two independent systems for copying data there between, are out of place when considering a single device alone, such as a camera.

Moreover, the examiner has failed to identify a motivation why, at the time the present invention was made, one of ordinary skill in the art would look to the computer and take those features, modify them, and put the computer features in a camera. The office action says that the result would be desirable "to allow a user to select and observe different images in difference recording medium and thereby easily select images to erase, transfer or store." With respect, the examiner appears to be using the current disclosure and claims as a guideline of what would be desirable and has then looked for the technical capability in the prior art to achieve goal. To reject the current claims the prior art must suggest the claimed invention. It is not enough that the prior art merely provides the building blocks from which the present invention could be assembled.

Accordingly, because Watanabe and Ohmori fail to disclose, suggest or teach combining their respective features and then modifying these features in a way to achieve the claimed invention, these references fail to render obvious the invention of claim 1.

Claims 2-4 depend from claim 1. Accordingly, claims 2-4 distinguish over the combination of Ohmori and Watanabe for at least the same reasons outlined for claim 1.

As presently presented, Claim 5 requires *inter alia*:

> A digital camera comprising:
> a reader which reads image data from a first recording medium and a second recording medium;
> a display which performs display of the image; and
> a display controller which causes said display to display essentially simultaneously a first image based on the image data read from the first recording medium and a second image based on the image data read from the second recording medium.

Thus, claim 5 is directed to a digital camera that has certain structures and capabilities. Specifically, the claimed camera must include a reading device which can read image data from multiple recording media and a display controller that can operate the display so as to simultaneously show image data from two different recording media.

As stated at page 5 of the Office Action, the Ohmori device does not teach a device that reads and simultaneously displays images read from two different recording media. Watanabe is cited as curing the deficiencies of Ohmori. However, as provided above regarding claim 1, there can be no motivation to combine Ohmori and Watanabe as suggested in the Office Action.

Accordingly, because Watanabe and Ohmori fail to disclose, suggest or teach combining their respective features and then modifying these features in a way to achieve the claimed invention, these references fail to render obvious the invention of claim 5.

Claim 6 depends from claim 5. Accordingly, claim 6 distinguishes over the combination of Ohmori and Watanabe for at least the same reasons outlined for claim 5.

Claim 10 depends from amended claim 7. As provided above in regards to the §102 rejection of claim 7, Ohmori fails to disclose that images are displayed according to a user specified rule "specified independently of the order in which the items of image data are recorded in the two or more recording media." It is respectfully submitted that

Watanabe also fails to teach this feature of claim 10. Accordingly, because Watanabe and Ohmori fail to disclose, suggest or teach combining their respective features and then modifying these features in a way to achieve the claimed invention, these references fail to render obvious the invention of claim 10.

As presently presented, Claim 11 requires inter alia:

> An image display method in a digital camera comprising:
> reading image data from one of two or more recording media; and
> displaying an image based on the image data and the information that specifies the recording medium from which the image data was read.

As provided above with regards to claim 1, the combination of Ohmori and Watanabe, though lacking the requisite motivation, still fails to teach or suggest "displaying information that specifies the recording medium from which the image data was read" as required by claim 11. Accordingly, because Watanabe and Ohmori fail to disclose, suggest or teach combining their respective features and then modifying these features in a way to achieve the claimed invention, these references fail to render obvious the invention of claim 11.

As presently presented, Claim 12 requires *inter alia*:

> An image display method in a digital camera comprising:
> reading image data from a first recording medium and a second recording medium; and
> displaying the first image based on the image data read from the first recording medium and the second image based on the image data read from the second recording medium, essentially simultaneously.

Thus, claim 12 requires simultaneously displaying images from two different recording media. As provided above with regard to claim 5, this feature is not taught or suggested by the proposed combination of Ohmori and Watanabe. Accordingly, because Watanabe and Ohmori fail to disclose, suggest or teach combining their respective features

and then modifying these features in a way to achieve the claimed invention, these references fail to render obvious the invention of claim 12.

Accordingly, it is respectfully requested that the rejection of claims 1-6, and 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Ohmori in view of Watanabe et al, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment increases the number of independent claims by 4 from 6 to 10 and increases the total number of claims by 8 from 13 to 21 (20 claims previously paid for), but does not present any multiple dependency claims. Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of $850.00 to be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and Fee Authorization form is missing, insufficient, or otherwise inadequate, or if a fee, other than the issue fee, is required during the pendency of this application, please charge such fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee,

and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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